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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,242	01/12/2001	Robert J. Davidson	10002343-1 (SEAG 77938)	2554

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EXAMINER	
SHELEHEDA, JAMES R	
ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/760,242	DAVIDSON, ROBERT J.	
	Examiner	Art Unit	
	JAMES SHELEHEDA	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8-20,22-26,28-32 and 34-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8-20,22-26,28-32 and 34-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 05/27/08 have been fully considered but they are not persuasive.

a. In response to applicant's arguments on pages 12-13, regarding claim 1, it is noted that Downs specifically discloses wherein access instructions will be stored after the entertainment media (as the access instructions are constantly being updated and stored based upon media usage; column 21, lines 43-63). Therefore, applicant's arguments are not convincing, as the combination of Chung and Downs meet the current claim limitations.

b. In response to applicant's arguments on pages 13-15, regarding claim 16, it is noted that Downs discloses wherein the software required to utilize the access instructions are available for download and installation at any time (column 80, lines 7-35). Thus, applicant's arguments that Downs is limited to "pre-defined" and "pre-formatted" devices are incorrect, as devices which are not predefined and preformatted may later be utilized by downloading the correct software.

c. In response to applicant's arguments regarding claim 9 and its dependents, it is noted that the newly added limitations indicated by applicant are

not supported by applicant's specification as originally filed. While the specification discloses storing the access instructions after the entertainment media is stored in memory (separately in time; page 5, lines 10-32), there is no specific support for the language of storing the access instructions "such that the access instructions are not embedded in the entertainment media". The specification is silent as to how the access instructions are specifically stored in memory, as they may or may not be embedded within the entertainment media. Therefore, applicant's regarding Chung and Downs are moot, as these claims are now rejected as containing new matter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5, 8-15, 19, 20, 22-26, 28, 32 and 34-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, lines 3-4, recite "before the storing the entertainment media step begins…storing access instructions in the memory" which is not supported by the specification as originally filed.

While the specification discloses storing the access instructions after the entertainment media is stored in memory (page 5, lines 10-32), there is no specific support for the language of storing the access instructions before the storing the entertainment media step.

Claim 4, lines 1-2, recite "repeating the storing the entertainment media step to store two or more entertainment media" which is not supported by the specification as originally filed.

The specification disclose storing one movie within the storage module prior to storing the access instructions (as required by claim 1; see page 5, lines 10-32). There is no specific support for repeating the storing step to store two or more entertainment media into the memory, when storing the media prior to storing the access instructions.

Claim 9, lines 6-8 recite "to store access instructions separately from the entertainment media in the memory such that the access instructions are not embedded in the entertainment media" which is not supported by the specification as originally filed.

While the specification discloses storing the access instructions after the entertainment media is stored in memory (separately in time; page 5, lines 10-32), there

is no specific support for the language of storing the access instructions "such that the access instructions are not embedded in the entertainment media". The specification is silent as to how the access instructions are specifically stored in memory, as they may or may not be embedded within the entertainment media.

Claims 34-36 recite "the portable digital storage module comprising a solid state storage device" which is not supported by the specification as originally filed.

While the specification discloses utilizing a "atomic resolution storage device" (page 6, lines 35-30) or "other subminiature devices" (page 7, lines 2-4), there is no specific disclosure of utilizing a solid state storage device, as recited in the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5, 8, 16-21, 23-26, 29-32 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (6,628,963) (of record) in view of Downs et al. (Downs) (6,226,618) (of record).

As to claim 1, while Chung discloses a method of portably handling entertainment media (column 1, lines 5-12) comprising:

storing the entertainment media in a memory of a portable digital storage module (column 1, lines 37-40, column 2, line 56-column 3, line 20),

he fails to specifically disclose after the storing the entertainment media step is completed, storing access instructions in the memory defining a prescribed authorized usage of the entertainment media.

In an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein digital content is downloaded onto a portable media player (column 6, lines 35-48) which is encoded with access instructions corresponding to a predefined limit of authorized playings of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55), which is stored in the memory after the entertainment media is stored within memory (storing new access instructions as the content is viewed and accessed; column 21, lines 43-63) to allow retrieval of the entertainment media in accordance with a permission granted by the access information (column 11, lines 30-55) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 50-60 and column 2, lines 26-34).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung's system to include after the storing the entertainment media step is completed, storing access instructions in the memory defining a prescribed authorized usage of the entertainment media, as taught by Downs, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 2, Chung and Downs disclose wherein the storing the entertainment media step further comprises transferring a copy of the entertainment media from a purchase center into the memory of the portable digital storage module (electronic digital content stores; see Downs at column 10, lines 4-35).

As to claim 3, Chung and Downs disclose wherein the storing the entertainment media step further comprises downloading the entertainment media from a remotely located database (see Downs at column 10, lines 4-35).

As to claim 4, Chung and Downs disclose repeating the storing the entertainment media step to store two or more entertainment media into the memory of the portable digital storage module (downloading and storing a plurality of movie files; see Chung at column 1, lines 5-12, lines 37-40 and column 2, lines 55-62).

As to claim 5, Chung and Downs disclose wherein the retrieving step is characterized by the digital format player device including a personal movie player (portable multimedia player; see Chung at Figs. 1 and 2; column 1, lines 20-30).

As to claim 8, Chung and Downs disclose wherein the storing step is performed in a broadband frequency format (MPEG format; see Chung at column 2, line 35 - column 3, line 11).

As to claim 16, while Chung discloses a portable digital media handling system (column 1, lines 5-12), comprising:

a system that receivingly engages a portable digital storage module in a data transfer relationship (column 1, lines 37-40, column 2, line 56-column 3, line 20), operably stores a user-selected entertainment media to the portable digital storage module (column 1, lines 37-40, column 2, line 56-column 3, line 20) according to a selected one of a plurality of different data communications formats (column 1, lines 41-57) and accessing the entertainment media by a digital format player device via the portable digital storage module (Fig. 3; column 2, line 40-column 3, line 20) by employing the selected communication format (column 1, lines 41-57), he fails to specifically disclose a purchase system and storing access instructions defining prescribed usage rights for playback of the user-selected entertainment media via the portable digital storage module by a common consumer industry format player device that is non-preformatted in relation to respecting playback limitations set forth by the usage rights.

In an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein purchased digital content is downloaded onto a portable media player (column 6, lines 35-48) which is encoded with access instructions corresponding to defined usage rights for playback of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55) to allow retrieval of the entertainment media in accordance with a permission granted by the access information (column 11, lines 30-55) by a common industry format player device that is non-preformatted in relation to respecting playback

limitations set forth the by usage rights (wherein the device is not pre-formatted and must have the software installed at a later time; column 80, lines 7-35) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 50-60 and column 2, lines 26-34).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung's system to include purchase system and storing access instructions associated with a predefined limit of authorized playings of the user-selected entertainment media via the portable digital storage module in order to prevent unauthorized access to the entertainment media by the digital format player device, as taught by Downs, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 17, Chung and Downs disclose wherein the digital format player device includes a personal portable playback device (portable multimedia player; see Chung at Figs. 1 and 2; column 1, lines 20-30).

As to claim 18, Chung and Downs disclose wherein the purchase system makes a copy of the user-selected entertainment media from a database of entertainment media and transfers a copy to the portable digital storage module via a point of purchase module (see Downs at page 9, line 60-column 10, line 35 and column 6, lines 35-49).

As to claim 19, Chung and Downs disclose wherein the storing access instructions step is characterized by granting permission to playback the entertainment media a finite number of times (see Downs at column 7, lines 41-55, column 20, lines 42-50 and column 61).

As to claim 20, Chung and Downs disclose wherein the storing access instructions step is characterized by granting permission to playback the entertainment media within a finite period of time (see Downs at column 7, lines 41-55, column 20, lines 42-50 and column 61).

As to claim 21, Chung and Downs disclose wherein at least a portion of a first entertainment media and at least a portion of a second entertainment media are stored in a common memory location (see Chung at column 1, lines 37-40, column 2, line 56-column 3, line 20).

As to claims 23 and 31, while Chung and Downs disclose a memory, they fail to specifically disclose a disc drive data storage device.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a disc drive storage device to store data, which are widely known and used to provide long term storage for data, for the typical benefit of taking advantage of a well-known storage device for long-term storage.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Downs' system to include a disc drive data storage device for the typical benefit of taking advantage of a well-known storage device for long-term storage.

As to claim 24, Chung and Downs discloses wherein the storing step is characterized by the entertainment media comprising audio data (see Chung at column 1, lines 6-14).

As to claim 25, Chung and Downs disclose wherein the storing step is characterized by the entertainment media comprising video data (see Chung at column 1, lines 6-14).

As to claim 26, Chung and Downs disclose wherein the storing the access instructions step is characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage (see Downs at column 61).

As to claim 29, Chung and Downs disclose wherein the database comprises a cable/satellite television network (see Downs at column 8, lines 42-53).

As to claim 30, Chung and Downs disclose wherein the point of purchase module comprises a cable/satellite receiver (see Downs at column 6, lines 36-48).

As to claim 32, Chung and Downs disclose wherein the storing access instructions step is characterized by automatically deleting the entertainment media from the memory according to the prescribed authorized usage (see Downs at column 11, lines 40-49).

As to claim 37, Chung and Downs disclose retrieving the entertainment media from the memory of the portable digital storage module with a digital format player device in accordance with permission granted by the access instructions (see Downs at column 11, lines 30-55).

As to claim 38, Chung and Downs disclose the user selected purchase price being determined by a users input to a point of purchase system (see Downs at usage tables, column 59 and column 61), wherein the entertainment media resides in the memory of the digital storage module prior to the user's input (column 78, lines 28-67).

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chung and Downs as applied to claim 1 above, and further in view of Gibson et al. (Gibson) (5,557,596) (of record).

As to claim 22, while Chung and Downs disclose storing the entertainment media, they fail to specifically disclose an atomic resolution storage device.

In an analogous art, Gibson discloses the use of an atomic resolution storage device (Figs. 1A-C; column 1, line 63-column 2, line 33) as opposed to conventional storage technologies (column 1, lines 14-21) for the typical benefit of providing ultra-high density storage with fast access times and high data rates (column 1, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Downs' system to include wherein the memory is characterized as an atomic resolution storage device, as taught by Gibson, for the typical benefit of taking advantage of the benefits provided by an atomic resolution storage device, such as fast access times and high data rates combined with ultra-high density storage.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung and Downs as applied to claim 1 above, and further in view of Yamagata.

As to claim 6, while Chung and Downs disclose wherein storing the digitally formatted movie further comprises providing the portable digital storage module with a communication interface (inherently present to allow the memory to interface and communicate with the player; see Chung at Fig. 1; column 2, lines 56-62), they fail to specifically disclose wherein the storage module has a power supply.

In an analogous art, Yamagata discloses a portable storage device (100) being coupled to a power supply (power supply circuit 150 and battery 130) for the typical

benefit of allowing the memory to record and reproduce information without the need for an external power supply (column 2, lines 39-40).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Chung and Downs' system to include the storage module having a power supply, as taught by Yamagata, for the typical benefit of allowing the memory to record and reproduce information without the need for an external power supply.

As to claim 7, Chung, Downs and Yamagata disclose wherein the retrieving step is characterized by a controller logic executing the access instructions stored in the memory (see Chung at column 2, lines 50-62).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Sheleheda
Examiner, Art Unit 2623

JS

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2623